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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,576	06/23/2003	Kinya Aota	503.35255VX1	9629

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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-9889

EXAMINER

STONER, KILEY SHAWN

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,576

Applicant(s)

AOTA ET AL.

Examiner

Kiley Stoner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/820,231.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-23-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/600,611. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general language used in the two applications is equivalent language within the art. In addition, it is obvious to one of ordinary skill in the art that a backing member could be a plate.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Midling et al. (WO 95/26254). Midling et al. teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding, a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figures 5a-5e). The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al. (5,460,317) of the IDS. Thomas et al. teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding, a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figures). The outer face of the structural body is

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relative to the direction in which the body is being viewed and does not structurally limit the article.

Claims 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by The 2nd International Forum of Aluminum Ships of the IDS. The International Forum teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding, a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figure 4); and a vehicle comprising: a first plate and a second plate welded together by a friction stir welding from one side of a thickness direction of said first plate and said second plate, a face of a welding portion of the friction stir welding of an opposite side, to said one side, of said first plate and said second plate being substantially flat, and said face of said opposite side being an outer face of the vehicle (Figure 4 and the title).

Claims 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Welding & Metal Fabrication of the IDS. Welding & Metal Fabrication teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding, a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face

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of said opposite side being an outer face of the structure body (Figure 1); and a vehicle comprising: a first plate and a second plate welded together by a friction stir welding from one side of a thickness direction of said first plate and said second plate, a face of a welding portion of the friction stir welding of an opposite side, to said one side, of said first plate and said second plate being substantially flat, and said face of said opposite side being an outer face of the vehicle (Figure 1 and page 4, column 1).

Claims 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Bulletin 6 of the IDS. Bulletin 6 teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding, a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figures 3-4 and page 3, column 3); and a vehicle comprising: a first plate and a second plate welded together by a friction stir welding from one side of a thickness direction of said first plate and said second plate, a face of a welding portion of the friction stir welding of an opposite side, to said one side, of said first plate and said second plate being substantially flat, and said face of said opposite side being an outer face of the vehicle (Figures 3-4 and page 3, column 3).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Childress (5,862,975). Childress teaches a structure body comprising: a first plate and a second plate welded to each other from one side of a thickness direction of said first plate and said second plate by a friction stir welding (Figure 2), a face of a welding portion formed by the friction stir welding, of an opposite side, to said one side, of said first plate and said second plate, being substantially flat, and said face of said opposite side being an outer face of the structure body (Figures 1-2; column 1, lines 13-18; column 2, lines 39-51 and claim 2); and a vehicle comprising: a first plate and a second plate welded together by a friction stir welding from one side of a thickness direction of said first plate and said second plate (Figure 2), a face of a welding portion of the friction stir welding of an opposite side, to said one side, of said first plate and said second plate being substantially flat, and said face of said opposite side being an outer face of the vehicle (Figures 1-2; column 1, lines 13-18; column 2, lines 39-51 and claim 2).

Conclusion

The prior art of record that is cited as of interest is presented on the form-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiley Stoner whose telephone number is (571) 272-1183. The examiner can normally be reached on Monday-Thursday (7:30 a.m. to 6:00 p.m.).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on Monday-Friday at (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KILEY S. STONER
PRIMARY EXAMINER

Kiley Stoner 12/14/04